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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,136	12/18/2001	Stephen W. Comiskey	53326.000012	9781

7590 06/21/2005

HUNTON & WILLIAMS  
ATTN: THOMAS J. SCOTT, JR.  
1900 K STREET, N.W.  
WASHINGTON, DC 20006

EXAMINER

PURVIS, SUE A

ART UNIT PAPER NUMBER

1734

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/020,136

Applicant(s)

COMISKEY ET AL.

Examiner

Sue A. Purvis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 41-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claim 41-47 drawn to an invention nonelected with traverse in Paper dated 27 October 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21-24 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al. (US Patent No. 4,719,909) in view of Essig (US Patent No. 1,300,592).

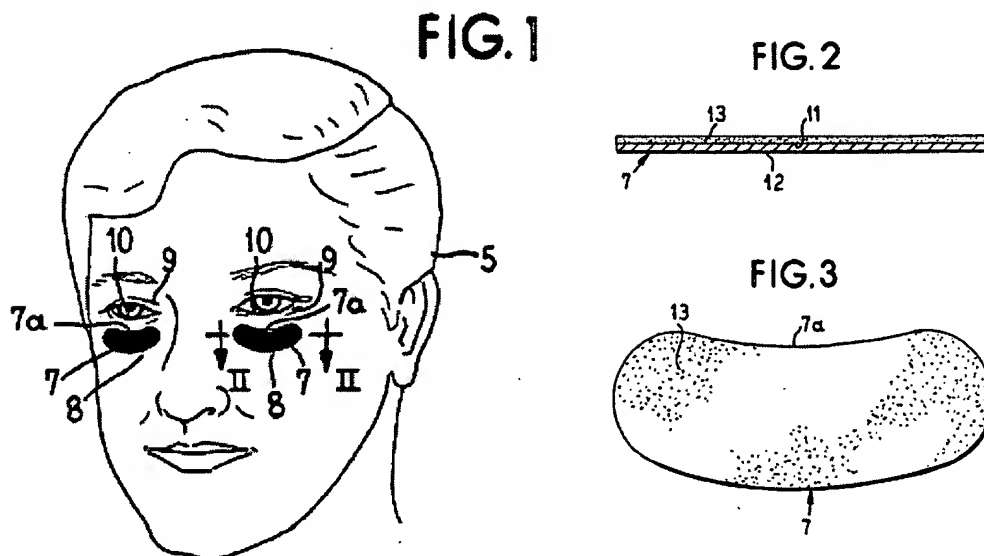
Regarding applicant claims 21 and 31, Micchia et al. disclose a method of reducing light glare into a human's eyes from the human's cheeks comprising the steps of:

(1) Providing a decal (patch) 7 comprising a shaped (kidney) body portion 11 having a light-absorbing, hypoallergenic (non-toxic), exterior black surface 12 (which would have a wavelength falling outside the range of 430 and 690nm) and also comprising an adhesive on the opposite surface 13 (Figures 1-3; column 2, lines 22-41; column 2, lines 49-50).

(2) Placing the decal 7 underneath the human's eyes on the cheek area defined by the zygomatic arch whereby incident light rays directed to the zygomatic arch area is

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substantially absorbed and reflection into the eyes is avoided (column 2, lines 14-21). The method of Micchia et al. is illustrated below:



Although Micchia et al. disclose the overall method and decal structure, they do not specifically disclose, as set forth in applicant claims 21 and 31, that the decal also comprises a shape formed within the exterior surface which has a color contrasting to the non-reflective color and is configured to provide communication.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the decal of Micchia et al. with a shape formed within the exterior surface which has a color contrasting to the non-reflective color in order to provide communication, motivated by the fact that Essig, also drawn to method for the formation and application of adhesively backed removable decals onto the human body, discloses that where a part of the decal (patch) 4 is to be exposed, it is desirable to impart a particular hue or color the exposed (outer or exterior) part of the decal (page 1, column 1, line 45 to page 1, column 2, line 68) such that the whole surface or only parts of the surface have

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surface ornamenting material applied thereto (page 1, column 2, lines 87-92). Essig further discloses that the ornamenting materials include inks, dyes, flock, tinsel (glitter) and the like (page 1, column 2, lines 68-71; page 1, column 2, lines 101-109). The method of Essig is illustrated below:



As illustrated above, the decal of Essig communicates to the viewer an image of a butterfly.

Although Micchia et al. do not specifically disclose, as per applicant claims 21 and 31, that the decal is removed within a week after application, it would have been obvious to one of ordinary skill in the art at the time of invention that the decal of Micchia et al. would have been removed within this time period motivated by the fact that they disclose that the major utility of the decal 7 is in connection with athletic activity such as football, baseball,

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basketball, tennis, golf and the like (column 3, lines 17-19) and furthermore by the fact that it is a well-understood general concept that such athletic activities generally span time periods of several hours to one day, but most definitely less than one week.

Regarding applicant claims 22 and 32, Micchia et al. disclose that the decal 7 utilizes a top face 12 comprising a non-reflective portion and a bottom face of pressure sensitive adhesive (PSA) 13 which facilitates the attachment of the decal 7 to the zygomatic cheek portion of the user when applied and pressed thereon (column 2, lines 22-26; column 3, lines 30-34).

Regarding applicant claims 23 and 33, Micchia et al. disclose that the exterior surface 12 of the decal 7 is colored/dyed black which would have a wavelength falling outside the range of 430 and 690nm (column 2, lines 37-41).

Regarding applicant claims 24 and 34, While Micchia et al. disclose that the decal 7 is suitable for use by a participant in an athletic contest (such as in football, baseball, basketball, tennis, golf and the like) and is applied immediately or near the beginning of the start of the contest (such as in the locker room or at the playing field - column 3, lines 3-7), they do not specifically disclose that the decal is removed within a "few" hours or less after the athletic contest or event is over. Nonetheless, the skilled artisan would have been appreciative of the fact that the decal 7 of Micchia et al. would be removed within a short period of time after the conclusion of the athletic contest or event motivated by the fact that it is well-known and generally accepted that equipment specifically designed for use during an athletic event (cleats, pads, etc.) is removed shortly after the conclusion of the event.

4. Claims 26-30 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al. in view of Essig as applied to claims 21 and 31 above, and further in view of Ross et al. (US Patent No. 5,470,351).

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Micchia et al. and Essig, as combined above, disclose a method for the reduction of light glare into a human's eyes from the human's cheeks through the use of a removable PSA decal having an outer light-absorbing portion which may be additionally decorated or modified by the inclusion of a contrasting colored shape or shapes within the outer boundaries of the decal outer (exterior) portion. Although they also disclose that the decal may be formed and decorated in such a manner as to provide communication (such as in the decal of Essig which communicates to the viewer an image of a butterfly), they do not specifically disclose, as per applicant claims 26-30 and 36-40, that the shape of the interior design and/or outer shape of the decal provide communication of a logo, name, or symbol of a sports activity, sport equipment maker, or other entities.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize the decal resulting from the combination of the Micchia et al. and Essig references to provide communication of a logo, name, or symbol of a sports activity, sport equipment maker, or other entities, as set forth in applicant claims 26-30 and 36-40,<sup>1</sup> motivated by the fact that Ross et al., also drawn to removable PSA decals (column 2, lines 54-58) for temporary application to the human body (column 2, lines 42-44; column 4, lines 5-16), disclose that the decal can be formed in such a way as to provide a precise shape forming a pattern, words or logo (column 2, lines 50-53). Furthermore, the specifics of the claimed pattern would have been the result of obvious design choice by the skilled artisan.

5. Claims 25 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al. in view of Essig as applied to claims 21 and 31 above, and further in view of Ross et al. (US Patent No. 5,470,351).

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<sup>1</sup> Note to Applicant regarding applicant claims 26-30 and 36-40: With regards to aesthetic design changes, it has been held (*In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)) that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

Micchia et al. and Essig, as combined above, disclose a method for the reduction of light glare into a human's eyes from the human's cheeks through the use of a removable PSA decal having an outer light-absorbing portion which may be additionally decorated or modified by the inclusion of a contrasting colored shape or shapes within the outer boundaries of the decal outer (exterior) portion. Although they also disclose that the decal may be formed and decorated in such a manner as to provide communication (such as in the decal of Essig which communicates to the viewer an image of a butterfly), they do not specifically disclose, as per applicant claims 25 and 35, that the decal is provided in the form of a tattoo and applied via transfer from a carrier substrate under the application of moisture and pressure.

Humason et al., however, also drawn to methods for the formation of decals for application to the human body via transfer, i.e., tattoos, disclose a process comprising the steps of:

(1) Providing a carrier substrate (decal paper) 18 having a plurality of decorative layers 12 disposed thereon wherein the decorative layers 12 define an exterior shape with contrasting colored shape or shapes within the outer boundaries of the decal in such a manner as to provide a communication - the decal tattoo of Humason et al. communicates to the viewer an image of a house (column 2, line 66 to column 3, line 42);

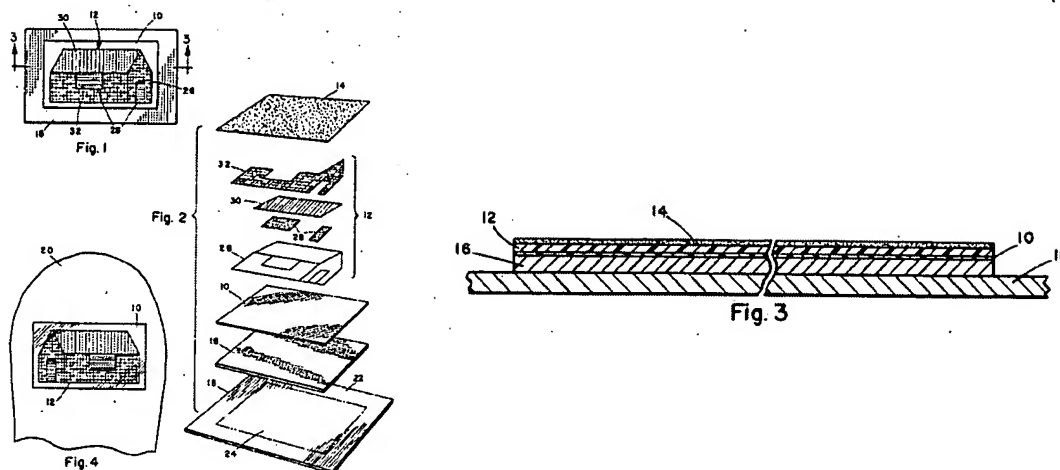
(2) Providing a clean skin surface 20;

(3) Pressing the side of the carrier substrate 18 having the plurality of decorative layers 12 against the surface of the skin 12;

(4) Wetting the exposed surface of the carrier substrate 18 with water during the pressing to ensure adhesion of the decorative layers 12 to the skin; and

(5) Peeling the carrier substrate 18 from the decorative layers 18 adhered to the skin surface (column 3, lines 43-55). The method of Humason et al. is illustrated below:





It would have therefore been obvious to one of ordinary skill in the art at the time of invention to apply the decal resulting from the combination of the Micchia et al. and Essig references in the form of a transferable tattoo, as suggested by Humason et al., motivated by the fact that Ross et al., also drawn to removable PSA decals (column 2, lines 54-58) for temporary application to the human body (column 2, lines 42-44; column 4, lines 5-16), disclose that the application of the decal by transfer from a carrier substrate is often preferable because the use of a carrier substrate avoids the crumpling or folding of the decal which could occur if application of the decal is attempted by removing it directly from its backing without the use of a transfer sheet (column 3, lines 34-47; column 4, lines 5-16).

### ***Response to Arguments***

6. Applicant's arguments filed 06 April 2005 have been fully considered but they are not persuasive.

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7. On page 11 of the applicant's response, the applicant argues there is no motivation to combine Micchia and Essig absent improper hindsight reasoning. In particular, the applicant suggest that the 'alleged "motivation" relied upon' was that Essig discloses an ornamental decal. This is misleading, because the motivation for combining the references actually comes from various places. First, the teachings in both references are similar in that they deal with applying a decal to the human body. Furthermore, Essig demonstrates that more than just slightly kidney shape decal can be applied, a decal which has a butterfly shape or other shape for that matter effectively communicates a different message to the person who sees it.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. On page 12 of the response, applicant states the "beauty mark of Essig is purely decorative and fails to provide communication." As stated above, the examiner disagrees with this assertion. A butterfly-shaped beauty mark communicates an idea of "beauty" to the observer which meets the claim limitations.

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11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the **knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art. There does not need to be some express recognition of a problem in the primary reference as suggested by the applicant.

12. On page 13 of the response, applicant states that motivation to combine can only be found in the prior art regarding the desirability of the combination of references. This assertion is inaccurate. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). (See MPEP §2143.01.) Here, the examiner has used the teachings of the prior art and persons of ordinary skill in the art to make the combination. One of ordinary skill in the art, based on the teachings of Essig, would appreciate that the kidney-shaped decal in Micchia et al. could be shaped differently in order to communicate something different to the observer.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

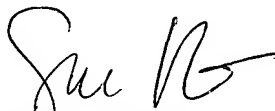
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
June 16, 2005